

REMARKS

Claims 1-36 were pending at the time of the Office Action. In this Amendment, claims 1-11, 16-29 and 34-36 were withdrawn from further consideration and claims 12, 15, 30 and 33 have been amended to clarify an aspect of the invention. Support is found in, for example, FIG. 3 and paragraphs [0056]-[0059] and [0072]-[0088] of the application-as-published. Claims 12-15 and 30-33 are currently pending for examination, of which claims 12 and 30 are independent. Care has been exercised not to introduce new matter.

REJECTION OF CLAIMS UNDER 35 U.S.C. §101

Claims 12-15 were rejected under 35 USC 101 as falling within one of the four statutory categories of invention.

In response, the preamble of claim 12 has been changed to “A method of inspecting a print image that is sequentially being processed **in a printing prepress system** by a plurality of sequential prepress processing steps.” The amended method claims 12-14 are tied a printing prepress system to inspect print image sequentially. Because the claimed subject matter in claims 12-14 is tied to a particular machine (a printing prepress system), the subject matter in those claims 12-14 should be patent eligible subject matter. *In re Bilski*, Case No. 07-1130 (Fed. Cir., 2008)

REJECTION OF CLAIMS UNDER 35 U.S.C. §112

Claims 12-15 and 33 were rejected under 35 USC 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With regard to indication of lack of antecedent basis for the term “the standard RIP processing conditions” in lines 11-12 of original claim 12 (line 13 of amended claim 12), the

term “the standard RIP processing conditions” has an antecedent basis on line 9 of original claim (lines 11-12 of amended claim 12). The Examiner mistakenly indicated the term “the standard RIP processing conditions” lacks antecedent basis.

With respect to the term “pages” in claims 15 and 33 indicated as lacking antecedent basis, the term “pages” has been changed to “page.”

In view of the above remarks and amendments to claims 15 and 33, the rejection is respectfully traversed.

REJECTION OF CLAIMS UNDER 35 U.S.C. §102

Claims 12 and 30 were rejected under 35 U.S.C 102(b) as being anticipated by Japanese Abstract and machine translation of Katsuya et al. (Publication No. 10-154234, hereinafter “Katsuya”). The rejection is respectfully traversed for the following reasons.

Amended claims 12 and 30 recite, in pertinent part, “(a first RIP processor for) preparing a first RIP data by executing RIP processing on a first print image data according to first RIP processing conditions,” and “(a second RIP processor for) preparing a second RIP data by executing RIP processing, in accordance with second RIP processing conditions that differ from the first RIP processing conditions, on a second print image data obtained by carrying out another prepress processing to the first print image data, the another prepress processing step being one of the sequential prepress processing steps excluding correction after proofreading.” As disclosed in FIG. 3, one example of what is recited in claims 12 and 30, the preflight processor 310 executes preflight processing on the original print image data PD0, and produces the print image data PD1, and prepares RIP data RIPD1 by RIP processing on the preflight processed print image data PD1. The signature/imposition processor 320 executes signature/imposition processing on the original print image data PD0 and produces the print

image data PD2. The signature/imposition processor 320 prepares preliminary proof RIP data RPD2 by executing RIP processing on signature/imposition processed print image data PD2. (See paragraphs [0072]-[0074] of the application-as-published)

Katsuya fails to disclose the limitations of claims 12 and 30 regarding “(a second RIP processor for) preparing a second RIP data by executing RIP processing, in accordance with second RIP processing conditions that differ from the first RIP processing conditions, on a second print image data obtained by carrying out another prepress processing to the first print image data, the another prepress processing step being one of the sequential prepress processing steps excluding correction after proofreading.”

Katsuya obtains the first raster type data by raster conversion of the original page description data. **The second raster type data is obtained not by performing raster conversion on the original page description data, but by performing raster conversion on the first raster type data, which has been subject to the raster conversion already.** In contrast, in subject matter of claim 12, the second RIP data is prepared by **executing RIP processing on a second print image data. The second print image data is obtained by carrying out another prepress processing to the first print image data**, which is one of the sequential prepress processing steps excluding correction after proofreading.

As anticipation under 35 U.S.C. § 102 requires that each element of the claim in issue be found, either expressly described or under principles of inherency, in a single prior art reference, *Kalman v. Kimberly-Clark Corp.*, 713 F.2d 760, 218 USPQ 781 (Fed. Cir. 1983), based on the foregoing, it is submitted that Katsuya does not anticipate claims 12 and 30. Thus, claims 12 and 30 and claims dependent thereupon have novelty over Katsuya.

REJECTION OF CLAIMS UNDER 35 U.S.C. §103

Claims 12-13 and 30-31 were rejected under 35 U.S.C 103(a) as being unpatentable over Katsuya as applied to claims 12 and 30 above, in view of Nahum (U.S. Patent Application Publication No. 2003/0026457, hereinafter “Nahum”). Claims 14-15 and 32-33 were rejected under 35 U.S.C 103(a) as being unpatentable over Katsuya in view of Nakagawa et al. (U.S. Patent No. 5,969,798, hereinafter “Nakagawa”).

As addressed above, Katsuya fails to disclose the limitations of claims 12 and 30 regarding “(a second RIP processor for) preparing a second RIP data by executing RIP processing, in accordance with second RIP processing conditions that differ from the first RIP processing conditions, on a second print image data obtained by carrying out another prepress processing to the first print image data, the another prepress processing step being one of the sequential prepress processing steps excluding correction after proofreading.”

In addition, Nahum, which was cited for converting images to a standard resolution, and Nakagawa, which was cited for the plate inspection system, fail to cure deficiencies of claims 12 and 30.

Accordingly, as each and every limitation must be disclosed or suggested by the cited prior art references in order to establish a *prima facie* case of obviousness (*see*, M.P.E.P. § 2143.03) and for at least the foregoing reasons the proposed combination of Katsuya, Nahum and Nakagawa fails to do so, it is respectfully submitted that claims 12 and 30 and claims dependent thereupon are patentable over the combination of Katsuya, Nahum and Nakagawa.

Conclusion

In view of the above amendments and remarks, Applicants submit that this application should be allowed and the case passed to issue. If there are any questions regarding this

Application No.: 10/692,746

Amendment or the application in general, a telephone call to the undersigned would be appreciated to expedite the prosecution of the application.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

McDERMOTT WILL & EMERY LLP



Hosang Lee
Registration No. L00,295

600 13th Street, N.W.
Washington, DC 20005-3096
Phone: 202.756.8000 SAB/HL
Facsimile: 202.756.8087
Date: February 13, 2009

**Please recognize our Customer No. 20277
as our correspondence address.**